

Allowable Subject Matter

Applicant thanks the Examiner for the indication that claim 14 would be allowable if rewritten in independent form. In view of Applicant's assertion that independent base claim 1 is patentable over the prior art of record, Applicant has elected not to rewrite claim 14 at this time.

Rejections under 35 U.S.C. §§ 102 and 103

In paragraph 5 of the Office Action, claims 1-10, 13, 15, 16, and 18-28 were rejected under section 102(b) as anticipated by or in the alternative, under section 103(a) as obvious over Tayebi '508. This rejection is respectfully traversed as being based upon a reference that does not teach or suggest the claimed invention.

Applicant has already argued, and continues to maintain, that Tayebi '508 does not teach a critical aspect of the invention, in that the retainer 19, 20 taught therein does not comprise a "filter cartridge" in that retainer 19, 20, at the time prior to being snapped into position on member 2, is *totally devoid* of any filter element and consequently cannot possibly constitute a "filter cartridge that has a housing into which a filter element is contained" as recited in claim 1 and similarly in all of the other claims. The Examiner has consistently disagreed with Applicant's position, asserting that Figure 3 "illustrates cartridge receiving structure (19) which 'contains' a filter (17), that is, the circumference of filter (17) is illustrated as being positioned within the confines of walls of the cartridge receiving structure (19); therefore, cartridge receiving structure (19) of Tayebi is disclosed as containing a filter (17)." Put simply, Applicant and the Examiner disagree as to what Figure 3 of Tayebi does or does not show.

It is axiomatic that "each prior art reference must be evaluated as an entirety..." *Panduit Corp. v. Dennison Manufacturing Co.*, 774 F.2d 1082, 227 USPQ 334, 337 (Fed. Cir. 1985), *vacated and remanded*, *Dennison Mfg. Co. v. Panduit Corp.*, 475 U.S. 809, 229 USPQ 478 (1986), *on remand*, 810 F.2d 1561, 1566, 1 USPQ2d 1593, 1595 (Fed. Cir.), *cert. denied*, 481 U.S. 1052 (1987). *See also Ultradent Prod., Inc. v. Life-Like Cosmetics, Inc.*, 127 F.3d 1065, 44 USPQ2d 1336 (Fed. Cir. 1997) (holding that district court erred in its anticipation analysis by construing the scope of the prior art patent's disclosure as limited to the preferred embodiment).

Similarly, "it is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of

other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.” *In re Wesslau*, 353 F.2d 238, 147 USPQ 391 (CCPA 1965).

It is therefore respectfully submitted that it is improper to consider Tayebi's Figure 3 in a vacuum, in the context of either a section 102 or a section 103 rejection. At the very least, it must be considered in conjunction with the other drawings and the disclosure of Tayebi '508.

An examination of Tayebi '508 in its entirety reveals that if Figure 3 is to be interpreted consistently with the remainder of the patent, the Examiner's interpretation of Figure 3 cannot stand. The structures shown in Figures 3 and 4 appear to be different. The retainer 19 shown in Figure 3 appears to have opposed projections that extend around the top and bottom of the filter 17 when the retainer is positioned in the mask shell 11, and the retainer appears to be held in place by friction. The retainer 19 shown in Figure 4 lacks the opposed projections of Figure 3, and simply sits on top of the filter 17, with its outer edges 20 engaging with a groove 22 in the mask shell 11 for a “snap fit.” However, Figure 4 is described as an isometric sectional view of the snap-in retainer 19 shown in Figure 3, and Figure 4a is described as showing further details of Figure 4 (column 10, lines 30-34 and 48-52). The description of the relationship between filter 17 and retainer 19 is found at column 10, lines 25-34:

Filter 17 may be permanently fastened inside of mask shell 11 over holes 12 by thermobonding or by adhesives for a disposable mask, or filter 17 may be detachably fastened inside of mask shell 11 over holes 12 by a snap-in retainer 19 as shown to create a reusable mask. Further details of retainer 19 are shown in FIG. 4, and further details of how retainer 19 holds replaceable filter 17 inside of mask shell 11 by being held in a molded recess around the inner wall of the shell 11 are shown in FIG. 4a.

The specification thus indicates that the filter 17 is positioned in a molded recess around the inner wall of the shell 11, and not in a recess in the retainer 19.

Invalidity based on anticipation under section 102 requires that each and every element and limitation of the claims is found within a single prior art reference. There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *Scripps Clinic & Research Found. v. Genentech, Inc.*, 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). It is respectfully submitted that at best, a person of ordinary skill interpreting Figure 3 in light of Tayebi '580 in its entirety would conclude that Tayebi '580 does not teach a housing into which a filter is contained; and at worst

that a person of ordinary skill interpreting Figure 3 in light of Tayebi '580 in its entirety would conclude that Tayebi '580 is inconsistent and/or ambiguous. Either way, a person of ordinary skill would be unable to conclude that there are no differences between the claimed invention and the embodiment of Tayebi '508 referenced by the Examiner.

Extrinsic evidence can be used to explain, although not to expand, the meaning of a reference, *Scripps Clinic, id., In re Baxter Travenol Labs*, 952 F.2d 388, 21 USPQ2d 1281 (Fed. Cir. 1991), or to fill a gap as to an asserted inherent characteristic of a reference. “Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.” *Continental Can Co., U.S.A. v. Monsanto Co.*, 948 F.2d 1264, 20 USPQ2d 1746 (Fed. Cir. 1991) (citing *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) (quoting *Hansgirk v. Kemmer*, 102 F.2d 212, 214, 40 USPQ 665, 667 (CCPA 1939)). See also *Finnigan Corp. v. Int'l Trade Comm'n*, --F.3d--, 50 USPQ2d 1001, 1008 (Fed. Cir. 1999) (Figure 2 of alleged anticipating article showed ions being ejected from a trap but the article itself did not contain any disclosure of how the ions were ejected from the trap; court held that expert testimony, although permissible to fill the gap in the disclosure, was not sufficient to establish unequivocally how the ions were ejected).

It follows from the above-cited case law that the prosecution history of the Tayebi '508 patent may be consulted to clarify its teachings.

Patent No. 4,856,508 is the first in a family of four patents issued to Tayebi, the other three (Patents Nos. 4,945,907; 5,080,094; and 5,094,236) being divisionals of the application that matured into the '508 patent. The application that matured into Tayebi '508 was the subject of a six-way requirement for election of species, the six identified species being: (1) Figures 1, 3, 4, and 4a; (2) Figure 2; (3) Figure 5; (4) Figure 7; (5) Figure 8; and (6) Figure 9. Species (5) was elected for prosecution in the application that matured into Tayebi '508. The application that matured into Tayebi '094 was directed to species (1). The prosecution history of the '094 patent thus provides some insight into what Tayebi really discloses as to the structure of the embodiment of Figures 3, 4, and 4a, the distinction between a “retainer” and a “cartridge,” and whether element 19 “contains” the filter 17 (the prosecution histories of the '907 and '236 patents focused on other features of Tayebi's invention, and thus does not address the “cartridge” structure

recited in the claims of the '508 and '094 patents). Throughout these prosecution histories, Tayebi's attorney consistently distinguished between a stand-alone filter and a filter that is held inside a separate housing or cartridge.* For example, on page 3 of the Response to the June 23, 1989 Office Action (date-stamped August 9, 1989), Tayebi's counsel argued:

In the present invention the filter 17 is not mounted in a plastic housing....

For a second example as seen in Figure 3 the filter material 17 may be retained against interior surface of the mask shell 11 by a thin, flat retainer 19 which permits the filter material 17 to be replaced. To replace the filter material the retainer 19 is held by force fit in a shallow-recess in the mask shell over the filter material (p. 20, l. 1-7). Further much of the retainer and the recess in which it is held are shown in Figures 4 and 4a, and are described in detail in the specification (p. 20, l. 1 to p. 21, l. 23).

On pages 3-4 of the Response to the November 22, 1990 Final Office Action (date-stamped December 23, 1990), Tayebi's counsel argued (emphasis added):

In contrast, the Applicant teaches and claims a filter element or liner that is placed directly against the mask shell and is retained in contact with same by a retainer as may be seen in Applicant's Figures 3 through 5. The retainers are easily removable to change the filter elements/liners. This is mentioned in the specification at page 21, lines 18 - 20....

The Brevik patent does teach the use of a "plastic foam; such as polyethylene and polypropylene having open cellular [*sic*, cellular] structures..." **The filter vessel [of Brevik] is still a cartridge vessel which is a container that contains the filter layers**, but the filters are never in contact with the mask shell. In addition, the filters are not replaceable.

This is not what the Applicant teaches and claims. The Applicant's filter layers are not contained in any vessel or container, but rather are placed directly against the mask shell and are retained there....

In contrast [to U.S. patent No. 4,592,350 to Maryyanek], **the Applicant teaches and claims a filter that is never inside a separate filter housing or**

* The Tayebi patents and their prosecution histories use the terms "filter cartridge" and "cartridge filter." However, a reference cannot anticipate the invention as recited in the rejected claims simply by possessing identically named parts, unless these parts also have the same structure or otherwise satisfy the claim limitations, and were understood to function in the same way by one skilled in the art. See *Applied Medical Resources v. United States Surgical Corp.*, 147 F.3d 1374, 47 USPQ2d 1289, 1293 (Fed. Cir. 1998).

cartridge but, rather, is placed directly against the mask shell and is held there by a retainer. The filters are replaceable. With the Applicant's invention there is no holder or other container to encompass the filter elements.

On page 10 of the Response to the April 11, 1990 Final Office Action (date-stamped June 27, 1990), Tayebi's counsel argued (emphasis added):

[The structure taught by Maryyanek] is entirely different than what is taught and claimed by the Applicant who does not use a holder to support the filter on both sides and to space the filter from the mask shell.

Similar or identical representations are made elsewhere in the '094 prosecution history and in the '508 prosecution history, in connection with the embodiments shown in Figures 2-4. Copies of the relevant pages are submitted herewith for the Examiner's reference, with the relevant passages highlighted in color.

The prosecution history is explicit: in the embodiment shown in Tayebi's Figures 3, 4, and 4a, the filter 17 is not mounted inside a plastic housing, holder, or cartridge, or in any structure that supports the filter on both sides. The filter 17 is positioned in a shallow recess and is retained in place by, but is not held within, the removable retainer 19.

In the face of such explicit statements, it is respectfully submitted that the Examiner cannot properly maintain his position that Tayebi '508 teaches "a filter cartridge (19, 20) that has a housing into which a filter is contained"; that the invention as recited in the pending claims is not taught or suggested by Tayebi '508; and that the rejections should be withdrawn.

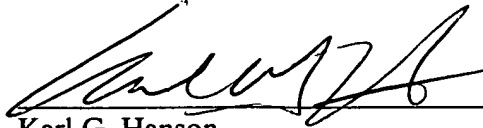
Conclusion

All rejections have been complied with, properly traversed, or rendered moot. Thus, it now appears that the application is in condition for allowance. Should any questions arise, the Examiner is invited to call the undersigned representative so that this case may receive an early Notice of Allowance.

Favorable consideration and allowance are earnestly solicited.

Dated this 20th day of September, 2000.

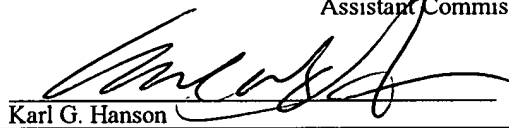
Respectfully submitted,



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Dated: September 20, 2000